



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 219002029400	
		Application Number 10/660,115	Filed September 10, 2003
		First Named Inventor Jonathan AXON et al.	
		Art Unit 1624	Examiner V. Balasubramanian

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant /inventor.
 assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)
 attorney or agent of record.
Registration number 44,422



Michael G. Smith
Typed or printed name

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

(858) 720-5113
Telephone number
October 11, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 798281457 US, on the date shown below in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 11, 2006

Signature:  (Grace Yu)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 798281457 US, on the date shown below in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 11, 2006

Signature: 

(Grace Axon)

Docket No.: 219002029400
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jonathan AXON et al.

Application No.: 10/660,115

Confirmation No.: 6854

Filed: September 10, 2003

Art Unit: 1624

For: INHIBITORS OF TGF β

Examiner: V. Balasubramanian

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This request relates to a final Office Action dated April 11, 2006, and an Advisory Action dated October 3, 2006. The claims at issue relate to compounds having pharmaceutical utility and methods of using these compounds to treat certain disorders. The outstanding rejections are based on alleged lack of enablement, and alleged obviousness over a single reference. For the reasons explained below, the claims are believed to be adequately enabled and non-obvious under the proper standards, and the rejections should be withdrawn accordingly.

35 U.S.C. 112 Rejection of claim 20

The Examiner rejected claim 20 because the specification allegedly "does not reasonably provide enablement for treating any or all diseases or conditions mediated by TGF β generically embraced in the claim language for reasons of record." According to the Examiner, this is a "reach-through" claim, which the Examiner described as "a claim drawn to a mechanistic, receptor binding or enzymatic functionality in general format and thereby reach through a scope of invention for which they lack adequate written description and enabling disclosure in the specification."

Claim 20 recites “A method to treat a fibroproliferative disorder or cancer associated with unwanted activity of TGF β ...”. It is thus drawn to treatment of specific conditions, cancer and fibroproliferative disorders, not to a mechanism of action *per se*. The recitation of “unwanted activity of TGF β ” further limits the claims, but a further limitation cannot expand the scope beyond the treatment of cancer or a fibroproliferative disorder, so the claim does not extend to subject matter that was not described or enabled.

The applicant provided references in the previous office action response demonstrating that, prior to the filing date of this application, persons of ordinary skill considered TGF β inhibitors capable of treating both fibroproliferative disorders and cancer.

In response to these references and explanations, the Examiner said this:

Applicants’ argument is also clearly indicative of emphasis on the mode of action and then reaching through to treat any or all diseases based on the mode of action.

The references submitted by the applicants as exhibits A-D were considered. Careful analysis would show that these are [sic] again would provide support for treating any or all fibroproliferative disorders or cancers. Hence, based on these considerations, the rejection is deemed as proper and is maintained.

Claim 20 recites treating cancer and fibroproliferative disorders “associated with unwanted activity of TGF β . ” It is therefore not drawn to the treatment of “any or all diseases or conditions” as the Examiner asserted, only to the named conditions, and the cited references demonstrate that these conditions were recognized in the art as ones that could be treated by compounds that inhibit TGF β . Indeed, the Examiner *stated* that the references “would provide support for treating any or all fibroproliferative disorders or cancers.” It is not clear how claims drawn to uses which the Examiner said are *supported by the references* could be considered non-enabled, or how written description could be lacking where the specification and claims refer to treatment of specific conditions using these art-recognized terms for those conditions. Thus written description and enablement are provided for the conditions in claim 20, and this rejection should be withdrawn.

35 U.S.C. 103 Rejection of Claims 1-19 and 22

The Examiner rejected these claims, which relate to a genus of compounds, over Kleeman, U.S. Patent No. 5,849,758 “in view of equivalency teaching of X as O with X as S in Kleeman.”

The Examiner's basis for asserting that Kleeman teaches "equivalency" of O with S consists of the fact that Kleeman discloses a genus wherein the structural feature corresponding to X in the present claims can be either O or S. However, Kleeman exemplifies only compounds wherein the feature corresponding to X represents O. The applicant pointed out that Kleeman does not suggest, expressly or otherwise, that O and S are "equivalent," and the Examiner never pointed to any evidence in Kleeman that suggests that O and S *are* equivalent.

From the mere recitation of S as one alternative in a Markush for the corresponding feature in Kleeman, the Examiner thus asserts that a *prima facie* case of obviousness is established, because the claimed genus could overlap with that in Kleeman when X represents S. However, this contradicts the legal standard for obviousness that is established by case law and summarized in MPEP 2144.06: "In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (The mere fact that components are claimed as members of a Markush group cannot be relied upon to establish the equivalency of these components....)" Thus the fact that Kleeman listed O and S as alternative features does not establish that O and S are equivalent. In addition, mere overlap of the claimed genus with that of Kleeman would not establish obviousness. The Federal Circuit has rejected such reasoning, as quoted in MPEP 2144.08(II), "The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness." *In re Baird*, 29 USPX2d 1550 (Fed. Cir. 1994).

The Examiner maintained the rejection in response to citation of these standards, relying on three statements:

First, the Examiner said, "it is noted that applicant's X is NR¹ or S and specification has only NR¹-Ar compounds not the S-analog. Based on applicants' argument it appears that applicants have no enablement. Applicants appear to use two different standards..."

This argument confuses the enablement and obviousness requirement, and the compound genus was not rejected for enablement. Analyzing enablement and obviousness *require* the use of two different standards, so there is no inconsistency in the applicant's position. Furthermore, it is

improper for the Examiner to rely upon the applicant's disclosure as the basis for interpreting a cited reference. The question is what the reference would have disclosed prior to the filing date, not what the *applicant* now discloses. Thus, what the present specification discloses is irrelevant to the question of what Kleeman would have disclosed at the time the present application was filed. Paradoxically, the Examiner even rejected claim 17, wherein X is *expressly limited to NH*, without any basis to assert that Kleeman discloses or suggests that NH is 'equivalent' to either O or S, further demonstrating that the rejection relies on the present disclosure rather than on what Kleeman would have disclosed.

Second, the Examiner said Kleeman's generic "is as good as instant statement of range of activity and does not teach away from the instant Markush choices. It merely points out some of O analogs had good activity. As much as instant specification shows variation among the compounds made, the reference compounds can also have such variations and it cannot by no means [sic] construed that all S analogs lack desired activity."

This relies on the present specification *and* focuses on the wrong issue. Applicant does not need to show that Kleeman's compounds containing S would have lacked activity had any been disclosed (none *were* disclosed in Kleeman), or that Kleeman "teaches away" from compounds containing S: the Examiner must establish a *prima facie* case of obviousness before the applicant can be required to offer rebuttal. The Examiner relied upon the asserted "equivalency" of O and S to allege obviousness, but under the above standard it is clear that O and S have not been shown to be 'equivalent' in the reference. The standards cited above dictate that mere recitation of O and S as alternatives for a structural feature does not establish their equivalency, and mere overlap of the presently claimed genus with one in the prior art does not establish a *prima facie* case of obviousness. Since no *prima facie* case for an obviousness rejection was ever established, the applicant need not provide rebuttal evidence.

Third, the Examiner said, "References must be considered under 35 U.S.C. 103, not only for what it expressly teaches but also for what it fairly suggests; all disclosures of prior art, including unpreferred embodiments must be considered in determining obviousness. *In re Bruckel* [sic: *Burckel*], 201 USPQ 67." That statement, though, is merely a broad generalization and in no way rebuts the applicable case law. *In re Burckel* is simply not informative here: it was not about

chemical inventions, it was not about the ‘equivalency’ of two items that both happened to be listed as alternatives for defining a prior art genus, and it was not about a claimed genus overlapping a prior art genus. It does not clearly provide a standard for the present situation, while *In re Baird* and *In re Ruff* do establish a clear, applicable standard. For example, the quote from *In re Burckel* refers to “unpreferred embodiments”, but the Examiner has pointed to no ‘unpreferred embodiment’ of Kleeman as the basis for the rejection, only the broad generic structure it discloses. That broad generic does not disclose or suggest that O and S are equivalent under the standard from *In re Ruff*, and using it to reject the present claims defies the legal standards of *In re Ruff* and *In re Baird*. Indeed, the court in *In re Ruff* quoted the same language from *In re Burckel*, then said that the disclosure of a large genus did not render obvious a small genus encompassed by the larger one because “that disclosure indicates a preference leading away from the claimed compounds.” Here, the disclosed preference—the only compounds exemplified by the reference—‘lead away’ from any compounds falling within the claimed genus.

Conclusion: The rejection based on Kleeman is inconsistent with the proper legal standards for an obviousness analysis for a chemical invention, and the Examiner has shown no reason those standards should not be applicable here. Accordingly, under the proper legal standards applicable to this situation, this rejection is invalid and must be withdrawn.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 219002029400. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: October 11, 2006

Respectfully submitted,

By 
Michael G. Smith - Registration No.: 44,422
MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040
(858) 720-5113